

REMARKS

This Amendment, filed in reply to the Office Action dated May 23, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-33 are all the claims pending in the application.

1. Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 1, 4, 7 and 19-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,697,090 to Nagasaka *et al.* ("Nagasaka") in view of U.S. Patent No. 5,666,215 to Fredlund *et al.* ("Fredlund").

Applicant hereinabove amends claims 1, 4 and 7 to describe that the simple output includes indication of the content of the order data for the data registered with the data management unit. The combination of Nagasaka and Fredlund does not teach these features. According to claims 1, 4 and 7, as amended, data selection and order content input can be carried out at one time and in a simple manner. The order for the data can be placed easily. Neither Nagasaka nor Fredlund discloses or suggests the structural feature and advantages of the present invention as claimed.

Further, Claims 3, 6, 9, 29, 31 and 33 recite "receiving an input of the content of a print order" (claims 3, 6 and 9) and "requesting print order information (claims 29, 31 and 33). The Examiner merely cites sections of Fredlund and/or Jackson to allege that the cited art has an ordering screen (Office Action at pages 5 and 6) but does not proffer any reason as to why it would have been obvious to modify the system in Nagasaka to include a screen where ordering information is taken.

Mere “identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). “[T]here must be some **motivation, suggestion or teaching of the desirability** of making the specific combination.” *Id.* (emphasis added.)

Here, the Examiner provides no motivation for modifying the system in Nagasaka as set forth in the claims, let alone one that is supported in the prior art. The motivation provided by the Examiner that display area 56 of Fredlund can server as a print preview screen, even if accurate, does not serve as a motivation to modify the system in Nagasaka to include the features set forth in at least claims 3, 6, 9, 29, 31 and 33.

Applicant submits that Nagasaka merely relates to transferring files between physical devices and software that attains the functions equivalent to those of physical devices. (Col. 2, lines 45-50.) The teachings of Fredlund and Jackson relate to ordering image services from image service providers (see respective abstracts and Summary of the Inventions). In the context of the teachings of Fredlund and Jackson and also the Examiner’s analysis, “order information” refers to the information required for purchasing of printing services from a photo processing lab, not merely the output from a physical device such as a printer or a facsimile machine.

The Examiner’s suggested modification would replace the simple physical devices of Nagasaka with photo processing labs. This would clearly change the principle of operation of Nagasaka. (See MPEP § 2143.02, the proposed modification cannot change the principle of operation of a reference.) Accordingly, Applicant submits that the Examiner has not made a *prima facie* case of obviousness. The rejection of unamended claims 28, 30 and 32 should be withdrawn for at least these reasons.

In addition, as conceded to by the Examiner, Nagasaka does not disclose that its output device can be opened to provide a simple output of the registered data. The fact that an intermediate device may be able to open stored input data in a manner similar to that of Digital Camera A is not relevant to the issue at hand. The issue is whether data sent to output devices are accessible for viewing in the same manner as the stored data in input devices. Nagasaka does not disclose or suggest that data sent to output devices can be viewed in a manner similar to the stored input data. Without such disclosure, any “expectation” that an intermediate device can be opened to view the “output data” in a manner similar to viewing the stored input data of Digital Camera A is based on pure speculation, not evidence.

Further, one skilled in the art would view the display area 56 of Fredlund as an image editing screen, not a print preview screen. The fact that display area 56 may provide a view of an image does not make it a “print preview screen.” The display area 56 relates to editing images, not a screen for verifying that the correct image has been selected for printing. Any subsequent photo processing done on the image displayed on display area 56 would not transform display area 56 from an image editing screen to a “print preview screen,” as recognized by one skilled in the art. Accordingly, the Examiner’s proffered reason for combining at least Nagasaka and Fredlund is not supported.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.116
U.S. Appln. No. 10/085,125

Attorney Docket No. Q66588

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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